

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte GERARDO BERTOLOSSO, MARIA MAVROPOULOU  
and ANDREW MURRAY

---

Appeal No. 2003-0635  
Application No. 09/196,818

---

ON BRIEF

---

Before KIMLIN, DELMENDO and JEFFREY T. SMITH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-21, all the claims in the present application. Claim 1 is illustrative:

1. An aqueous hair treatment composition comprising, in addition to water:

- i) an amino functionalised silicone; and
- ii) emulsified particles of an insoluble, hydroxyl functionalised silicone.

Appeal No. 2003-0635  
Application No. 09/196,818

In the rejection of the appealed claims, the examiner relies upon the following references:

Murray (Murray '363)	6,194,363	Feb. 27, 2001
Murray (Murray '361)	6,277,361	Aug. 21, 2001
Houiellebecq et al. (Houiellebecq) (United Kingdom Patent Application)	2,173,515	Oct. 15, 1986

Appellants' claimed invention is directed to a hair treatment composition comprising water, an amino functionalized silicone, and emulsified particles of insoluble, hydroxyl functionalized silicone. According to appellants, "it has been found that superior conditioning over dimethicone-based systems can be obtained by utilizing emulsified hydroxyl functional silicone in combination with amino functionalized silicone" (page 9 of Brief, last paragraph).

Appealed claims 1-21 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Houiellebecq. Claims 1-15 and 19-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,194,363. Also, claims 1-8, 12-15, 20 and 21 stand rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,277,361.

Appeal No. 2003-0635  
Application No. 09/196,818

Appellants submit at page 11 of the Brief that "[c]laims 1, 10, 11, 16, 17, 18, 20 and 21 stand or fall by themselves," and that "[c]laims 2-9, 12-15 and 19 stand or fall by themselves." Accordingly, the appealed claims grouped with claim 1 stand or fall together with claim 1, whereas the claims grouped with claim 2 stand or fall together with claim 2.

At the outset, we note that appellants do not contest the examiner's rejections under obviousness-type double patenting. Rather, appellants state that they "stand ready to file a Terminal Disclaimer to overcome these double patenting rejections" (page 10 of Brief, last sentence).

We have thoroughly reviewed the respective positions advanced by appellants and the examiner with respect to the § 102/§ 103 rejection. In so doing, we concur with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied Houiellebecq reference. Accordingly, to the extent the examiner's rejection is based on § 103, we will sustain it for essentially those reasons expressed by the Answer.

There is no dispute that Houiellebecq, like appellants, discloses a composition for treating hair comprising water, an amino functionalized silicone and a hydroxyl functionalized

silicone. The thrust of appellants' argument is that "Houiellebecq fails to disclose either expressly or inherently an insoluble hydroxyl functionalized silicone" (page 12 of Brief, fourth paragraph, emphasis added). Although Houiellebecq discloses that the hydroxy functional silicone derivative is preferably a flake silicone solid, and is mixed with a solubilizing or suspending agent, appellants maintain that "[t]he final physical form which the hydroxyl functionalized silicone would take in a composition of Houiellebecq simply cannot be derived" (page 13 of Brief, second paragraph), and that "Houiellebecq is simply silent on whether or not the hydroxy functional silicone is prepared as insoluble" (page 13 of Brief, third paragraph).

We do not agree with appellants' characterization of Houiellebecq as ambiguous with respect to the physical form of the hydroxy functional silicone derivative. Inasmuch as Houiellebecq expressly teaches that the derivative can be mixed with a solubilizing or suspending agent, and prepared with an admixture of water which can dissolve or support the derivative, we are of the opinion that one of ordinary skill in the art would have gleaned that Houiellebecq embraces hydroxy functional silicone derivatives which can be either dissolved or suspended

in the emulsion in insoluble form. Also, we note that there is general correspondence between methods by which the compositions of Houiellebecq and appellants are prepared. Specifically, appellants' specification states that the emulsions may be prepared "by emulsifying the silicone with water and an emulsifier (mixing the silicone into a heated solution of the emulsifier for instance)" (page 8, lines 28-30), whereas Houiellebecq discloses that the preparation process preferably includes an emulsion base and that "the hydroxy functional silicone derivative is dissolved in the solubilising or suspending agent, such as a long chain fatty alcohol, ester or ketone, by warming to a temperature of from about 70°C to 80°C" (page 4, lines 4-6). Manifestly, insofar as elevated temperatures are required to dissolve or suspend the hydroxy functional silicone derivative, the hair treatment composition, at room temperature, would include the derivative in an insoluble form.

As for the claim 2 requirement that the ratio of amino functionalized silicone to hydroxyl functionalized silicone is 1:2 or less, the examiner has properly noted that Houiellebecq teaches a range of ratios which encompass the claimed ratio,

Appeal No. 2003-0635  
Application No. 09/196,818

thereby rendering the claimed ratio prima facie obvious. In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, which establishes criticality of the claimed ratio or that compositions within the scope of appealed claim 1 exhibit unexpected results.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
	)	
ROMULO H. DELMENDO	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY T. SMITH	)	
Administrative Patent Judge	)	

ECK:clm

Appeal No. 2003-0635  
Application No. 09/196,818

Unilever  
Patent Dept.  
45 River Road  
Edgewater, NJ 07020